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Supreme Court, U.S.
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No. A-921 (93-1577)

In The

Supreme Court of the United States

October Term, 1993

QUALITEX COMPANY

Petitioner,

v.

JACOBSON PRODUCTS CO., INC.

Respondent,

On Petition For Writ of Certiorari
To The United States Court Of Appeals
For The Ninth Circuit

BRIEF IN OPPOSITION

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25 pp

QUESTIONS PRESENTED

1. Whether the instant case presents an actual case or controversy for adjudication by this Court;

2. Whether the settled rule generally denying registration of color *per se* requires review and adjudication by this Court;

3. Whether the Ninth Circuits cancellation of United States Patent and Trademark Office Certificate of Registration No. 1,633,711 in the name of Qualitex Company for the green-gold color of the Qualitex press pads presents a sufficiently novel or important question such that the writ should be granted.

PARTIES TO THE PROCEEDINGS BELOW

Respondent JACOBSON PRODUCTS CO., INC. was the Defendant-Appellant in the Court of Appeals. JACOBSON PRODUCTS CO., INC., has no parent or subsidiary company.

Petitioner QUALITEX COMPANY was the Plaintiff-Appellee in the Court of Appeals.

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STATEMENT OF THE CASE

This case does not involve, as posited by Qualitex, the "cancellation ... of a trademark registration ... for a trademark comprised of a color" (*Petition,* p.6). This case involves the question of whether the color of the *product itself* may be protected as a trademark under the Lanham Act, where such color is not employed in association with a name, symbol, device, design or logo.

Even before the Court considers whether this question warrants granting of the instant writ, this Court must first decide in the first instance whether the instant writ presents a requisite actual case or controversy for adjudication by the Court.

I. Factual Background

Jacobson has been in business since 1951 and is a well-known manufacturer and distributor of products used in the commercial dry-cleaning business (*Petition,* App. B, 18a, ¶22). Jacobson supplies approximately 600 products to the dry cleaning and garment industries through 450-500 distributors. (*id.*). Jacobson was the inventor of a product known as the "Magic Ironing Shoe" and many of its products are sold using the word "Magic ...". Jacobson is so well known in the dry cleaning industry that the President of Qualitex testified at trial that the word "Magic" has become exclusively associated with Jacobson products in the dry cleaning industry. R.T. Vol. I, 107:16 - 108:17). Jacobson called its press pad the "Magic Glow" pad in order to take advantage of that strong industry association. R. 73.

Prior to June, 1988, Jacobson marketed a press pad known as the "Bishopad" manufactured by Bishop Freeman

Company. *Petition,* App. B, p. 18a. After June 1989, Jacobson began to manufacture and sell a press pad that was identical in color to the "Sun Glow®" pad manufactured by Qualitex, but clearly and unambiguously marketed under the Jacobson name. *id.* At trial, the principals of Jacobson were forthright in their testimony that Jacobson attempted to duplicate the color of the Qualitex press pad *(id.,* 18a-20a, ¶¶26-35).

However, the trial record shows that, other than the identity of color of the respective press pads and their respective shapes (a purely functional feature dictated by the shape of the steam press on which the pads are intended to be used, *e.g.* R. 73), there were and are no other similarities between the two pads. Jacobson and Qualitex each sold their respective press pads under each of their already well-established tradenames, and, in the case of Qualitex, the press pad was sold under a prominent brand name registered as a trademark by Qualitex - the "Sun Glow®" Pad. The packaging on the Qualitex box containing the press pads used a shade of green entirely different than the shade used on the press pads themselves. R. T. Vol. I, 60:10-13). Jacobson marketed its press pad under the brand name "Jacobson's Magic Glow" pad. At no time did Jacobson ever attempt to "pass off" a "Magic Glow" pad as a Qualitex "Sun Glow®" pad, nor did the district court ever make such a finding.

Ever since the injunction was entered by the district court, Jacobson has lawfully obeyed the injunction and has not attempted or threatened to market a press pad duplicating the color used by Qualitex. Even if this Court were to grant the instant writ and ultimately rule that the the registered Qualitex color mark should be reinstated on the Principal Register of the Patent and Trademark Office, Jacobson legal duties to Qualitex under the already existing

injunction will be unaffected. No decision by this Court will affect the rights of Jacobson in terms of the ultimate relief sought by Qualitex in this case (Qualitex won the injunction it sought) and no decision by this court will affect the ultimate outcome of the case: the district court's award of damages and injunctive relief to Qualitex as affirmed by the Ninth Circuit.

II. Summary of Argument

A. As To The Case or Controversy Requirement.

The instant writ fails to present an actual case or controversy to this Court for adjudication. Jacobson will be entirely unaffected by the outcome of this appeal. The district court has enjoined Jacobson from manufacturing or selling a press pad with the same or confusingly similar color as that used on the Qualitex "Sun Glow®" pad. That injunction was based on the separate and independent findings by the district court that Jacobson had infringed the registered Qualitex color mark and upon the district court's finding that Jacobson violated the unfair competition provisions of §43(a) of the Lanham Act. Because the subject injunction remains in effect based on the factual grounds set forth in the separate, independent unfair competition findings made by the district court, it matters not to Jacobson whether this Court reinstates the Qualitex registered mark, in essence "reactivating" the alternate ground on which the injunction was originally based. Either way, Jacobson is enjoined from duplicating the color of the Qualitex press pad.

While this case might have presented an actual, ongoing controversy to the Ninth Circuit (Jacobson appealed

from all findings of the district court, including the judgment re: unfair competition), it does not present such a situation to this Court now.

B. As To The Trademark Issues

While there admittedly appears to be a split between the Federal Circuit and the Eighth Circuit, on the one hand, and the Third, Seventh and Ninth Circuits, on the other hand, as to the issue of trademark protection for color *per se*, a split between the circuits alone cannot substitute for a constitutionally required actual case or controversy and is insufficient in and of itself to invoke the discretionary jurisdiction of this Court.

In any event, there is no compelling reason why this Court should review the decision below of the Ninth Circuit. The overwhelming majority view in both the federal circuits and state courts is that trademark protection should be denied for mere color *per se* employed on the product itself because sufficient protection for color exists when color is incorporated in a symbol, device or design that is registerable under the Lanham Act. This is a settled point of law, and the Ninth Circuit did nothing more than follow the historical majority view as to the instant issue.

This Court has once denied *certiorari* in a case raising an identical issue, *Nutrasweet Co. vs. Stadt Corp.* (7th Cir. 1990) 917 F.2d 1024, *certiorari denied* 111 S. Ct. 1640, 113 L.Ed.2d 735, even though such denial of *certiorari* clearly left standing a conflict between the Federal Circuit and the Seventh Circuit as to the precise issue in question here. There is no new compelling reason why *certiorari* should be granted in the instant case.

C. As To The Propriety Of Cancellation Of The Qualitex Mark.

The Ninth Circuit acted well within its jurisdiction and perogative when it ordered cancellation of the Qualitex registered color mark. The final determination of whether a particular asserted mark is protectible as a trademark or registerable under the Lanham Act is a question of law that may properly be determined in the final instance by the federal courts, notwithstanding contrary findings of the Patent and Trademark Office. The instant case presents no novel or important question of law sufficiently compelling to warrant granting of the writ.

REASONS FOR DENYING THE WRIT

I.

THE WRIT DOES NOT PRESENT AN ACTUAL CASE OR CONTROVERSY TO THIS COURT

It is axiomatic constitutional law that this court may only adjudicate actual cases or controversies. *Burke v. Barnes,* (1987) 479 U.S. 360, 362, 107 S.Ct. 734, 736, 93 L.Ed.2d 732. As this Court stated in *Honig v. Doe*, (1987) 484 U.S. 305, 318, 108 S.Ct. 592, 601, 98 L.Ed.2d 686:

> "Under Article III of the Constitution this Court may only adjudicate actual, ongoing controversies. *Nebraska Press Ass'n v. Stuart,* 427 U.S. 539, 546, 96 S.Ct. 2791, 2796, 49 L.Ed.2d 683 (1976); *Preiser v. Newkirk,* 422 U.S. 395, 401, 95 S.Ct. 2330, 2334, 45 L.Ed.2d 272 (1975). That the

> dispute between the parties was very much alive when the suit was filed, or at the time the Court of Appeals rendered its judgment, cannot substitute for the actual case or controversy that an exercise of this Court's jurisdiction requires. *Steffel v. Thompson*, 415 U.S. 452, 459, n. 10, 94 S.Ct. 1209, 1216, n. 10, 39 L.Ed.2d 505 (1974); *Roe v. Wade*, 410 U.S. 113, 125, 93 S.Ct. 705, 713, 35 L.Ed.2d 147 (1973)."

The instant case does not present such a justiciable controversy to this Court. Jacobson has paid the damages awarded by the district court to Qualitex, is enjoined from duplicating the color of the Qualitex press pad, and would remain enjoined irrespective of whether this Court grants the writ, hears the Qualitex appeal, and reinstates the subject certificate of registration to Qualitex. Both the award of damages and the issuance of the subject injunction can be separately sustained on the district court's unfair competition findings. Thus, the only party that will be affected by this appeal is Qualitex, which apparently now seek to enlist this Court as its trademark counsel vis a vis the Ninth Circuit.

The Qualitex complaint alleged that the duplication of the color of its press pad by Jacobson infringed the Qualitex trademark and constituted unfair competition under §43(a) of the Lanham Act. R.1. The Complaint sought damages and, most important to Qualitex, an injunction against further alleged infringement by Jacobson *id.* The district court awarded both damages and the injunction sought by Qualitex (*Petition,* App. B, p. 29a). The fact that the injunction issued by the district court was based on the unfair competition findings as well as the trademark infringement findings, *id.*, and can be independently sustained thereon, renders this case non-justiciable because

the outcome of the case, and the relief awarded to Qualitex, will not be affected. In essence, Qualitex seeks to have this court issue what amounts to an advisory opinion on Qualitex's right to the alleged mark. The argument advanced by Qualitex to the effect that a registered mark grants heavier and more substantive rights than the trade dress protection awarded by the district court (*Petition,* p.8, n. 4) does not transmute what amounts to a non-justiciable dispute into an actual case or controversy.

Because the instant case does not present a requisite actual case or controversy to this Court for adjudication, the instant writ should be denied.

II.

ABSENT AN ACTUAL CASE OR CONTROVERSY, AN ALLEGED CONFLICT BETWEEN CIRCUITS ALONE DOES NOT WARRANT GRANTING OF THE WRIT; IN ANY EVENT, THE NINTH CIRCUIT DID NOTHING MORE THAN FOLLOW THE OVERWHELMING MAJORITY VIEW WHEN IT FOUND THAT THE COLOR OF THE QUALITEX PRESS PAD WAS NOT PROTECTIBLE AS A TRADEMARK AS A MATTER OF LAW

A. An Alleged Conflict Between Circuit Courts Is Irrelevant Absent an Actual Case or Controversy.

The simple fact that an alleged conflict exists between circuit courts on any particular point of law is

irrelevant if the case at bar fails to present a constitutionally justiciable case for review. *Honig v. Doe, supra.* In the instant case, there had been no evidence whatsoever presented by Qualitex which demonstrates that this Court has been presented with an actual case or controversy. There is no evidence that Qualitex faces "some likelihood" that it will face the same alleged wrongful conduct on the part of Jacobson again or that such prospect is "reasonably likely" , *see, e.g. United States Parole Comm'n v. Geraghty,* 445 U.S. 388, 398, 100 S.Ct. 1202, 1210, 63 L.Ed.2d 479 (1980); *Burlington Northern R. Co. v. Maintenance of Way Employees*, 481 U.S. 429, 436, n. 4, 107 S.Ct. 1841, 1846, n. 4, 95 L.Ed.2d 381 (1987). Absent an actual case or controversy, the Court need not reach the issue of whether a sufficient conflict between the circuit courts exists that the instant writ should be granted.

B. Review Of The Ninth Circuit's Opinion Is Unnecessary Because The Case Was Resolved By The District Court On Factual Grounds That Did Not Involve Differing Views Of The Law

As set forth above, the injunction issued by the district court in this case was based on two separate independent findings: first, that Jacobson had infringed Qualitex's valid registered color mark (*Petition,* App. B, p. 29a, ¶32) and, second, that the color of the Qualitex pad was protectible trade dress and that Jacobson had committed unfair competition under §43(a) of the Lanham Act when Jacobson duplicated that color (*Petition,* App. B, p. 29a, ¶34). The latter ground was entirely fact-driven, based primarily on Qualitex's showing that the color of the Qualitex pad had achieved secondary meaning (*Petition,*

App. B, pp. 16a-21a), and constitutes an adequate basis for the district court's award of monetary damages and injunctive relief to Qualitex and did not involve any resolution by the district court of differing legal views on an unsettled issue of law.

In such circumstances, where a case can be or was resolved on adequate factual grounds not involving differing views of the law, *certiorari* should be denied. *Wisconsin Electric Co. v. Dunmore Co.,* (1931) 282 U.S. 813, 51 S. Ct. 214, 75 L.Ed. 728.

C. The Ninth Cirucit Did Nothing More Than Follow The Overwhelming Weight of Authority When It Ordered Cancellation Of The Qualitex Color Mark

The opinion of the Ninth Circuit (*Petition*, App. A) did nothing more than follow the overwhelming weight of authority on the issue of whether color *per se* alone can ever act as a trademark. The Court need not become involved in what amounts to a settled rule of law.

A color *per se* is a color used in a uniform, non-distinctive manner, and not in connection with any definite arbitrary symbol or design. McCarthy, *Trademarks and Unfair Competition* §7:26 (2d Ed. 1984) (hereinafter "McCarthy, Trademarks"). Jacobson would submit that it is settled law that colors *per se* cannot be monopolized as trademarks. As long ago as 1906, the Court in *Diamond Match Co. v. Saginaw Match Co.* 142 Fed. 727 (6th Cir. 1906) stated:

> "Sometimes a color, taken in connection with other characteristics may serve to distinguish one's goods and thus be protected by the courts, but, as a rule a color cannot be monopolized to distinguish a

product."

In *Life Savers Corp. v. Curtiss Candy Co.* 182 F.2d 4,9 (7th Cir. 1950), the Court, citing the Seventh Circuit in *Diamond Match*, supra, stated:

> "As a rule color cannot be monopolized to distinguish a product. Color is not subject to trade-mark (sic) monopoly except in connection with some definite arbitrary symbol or design."

In *Campbell Soup Co. v. Armour & Co.* 175 F.2d 795, 798 (3d Cir.), cert. denied 338 U.S. 847, 70 S.Ct. 88, 94 L.Ed. 518 (1949), the Third Circuit pointed to the limit of the number of available colors as one reason for the "absolute prohibition" against the protectability of color *per se*.

As described by Professor McCarthy, the mere color rule specifies: "A color, per se, is not capable of appropriation as a trademark. That is, one seller cannot feature a certain color and claim that 'This is my color. No one else in the trade can use this color'". McCarthy, *Trademarks*, §7:16.

Virtually every Court, save and except the extremely narrow decision by the Federal Circuit in *In re Owens-Corning Fiberglas Corp.* (Fed. Cir. 1985) 774 F.2d 1116 and the anomolous opinion of the Eighth Circuit in *Master Distributors, Inc. v. Pako Corp.* (8th Cir. 1993) 986 F.2d 219, has soundly and firmly rejected claims of trademark protection for color *per se*. See, *Smith Kline & French Co. v. American Druggists Syndicate* 273 F. 84 (2d Cir. 1921) (red background color of aspirin label not protectable); *Re L.E. Waterman Co.* 34 App.D.C. 185 (1909) (color of fountain pen); *Shaeffer Pen Co. v. Coe* 27 F.Supp. 380 (D.C. 1939) (plating in a particular color); *Omega Oil v.*

Weschler 71 N.Y. Supp. 983, 35 Misc. Rep. 441; (green color of soap and soap box); *Southern California Fish Co. v. White Star Canning Co.* 45 Cal.App.426, 431, 187 Pac. 981, 983 (1920); *Taylor v. Bostick* 299 F. 232 (3d Cir. 1927) (gold label color not protectable); *Fram Corp. v. Boyd* 230 F.2d 931 (5th Cir. 1956) (orange and black color of box packaging not protectable); and *Lufkin Rubber Co. v. Master Rule Mfg. Co.* 40 F.2d 991 (U.S. Cust. & Pat Appeals, 1930). The color asserted to be a trademark in the instant case is not a decorative design or color scheme, but the color of the product itself.

Throughout this case, Jacobson has argued that Qualitex has read too much into the *Owens-Corning* opinion. The facts in that case were described by the Ninth Circuit in *First Brands Corp. v. Fred Meyer, Inc.* (9th Cir. 1987) 809 F.2d 1373, 1382 as "an extraordinary situation" and an "unusual set of facts", *id.* No such extraordinary facts appear in the case at bar because the facts in *Owens-Corning* are far different from those in the instant case, no matter how hard Qualitex seeks to demonstrate to the contrary. *Owens-Corning* was the only manufacturer of wall insulation to have colored its product over a period of more than 20 years and to have based advertising on that color. All other wall insulation manufacturers sold the product in its native straw color.

In the instant case, all press pad manufacturers apply color to their respective press pads. Qualitex has used the "Sun Glow®" green-gold color for many years, but other press pad manufacturers have used color on their pads for many years as well. (*Petition*, App. B, p. 22a, ¶58). Jacobson introduced substantial evidence at trial that a white or uncolored pad is unsaleable because the pad becomes scorched with use and is rendered unsightly if color is not present to mute or disguise the inevitable scorch marks. In (*Petition*, App. B, p. 22a, ¶53). In fact, the district court

specifically found that there is a competive need for color in the manfacture of press pads. (*Petition*, App. B, p. 22a, ¶58).

Jacobson has consistently argued that the opinion in *Owens-Corning* should be limited to those "unusual" facts and that the case should not be viewed as repudiating the color depletion theory. Unfortunately, the Eighth Circuit chose to view the *Owens-Corning* opinion much more broadly than the opinion warrants. However, unlike *Owens-Corning* and the Ninth Circuit's opinion in the case at bar, the opinion of the Eighth Circuit in *Master Distributors* arose not from a fully litigated judgment but from reversal of summary judgment. Indeed, the case was at such an early stage that the Eighth Circuit reversed the district court's findings on the trademark and unfair competition findings because it was improper to grant summary judgment "at this early stage with regard to such a factual issue" to allow more discovery thereon to be taken. *Master Distributors, supra,* at 986 F. 2d at p. 225.

Thus, all the Ninth Circuit did in its opinion was to follow the overwhelming historical majority view on this issue. This Court need not and should not be called to resolve or judge the majority and minority views on every point of federal law, and should not and need not do so in the case at bar.

III.

THE ISSUES RELATING TO WHETHER THE NINTH CIRCUIT PROPERLY CANCELLED THE QUALITEX COLOR MARK DO NOT PRESENT SUCH NOVEL OR IMPORTANT QUESTIONS OF LAW THAT GRANTING THE INSTANT WRIT ON THAT BASIS ALONE IS COMPELLED

Qualitex makes much of the fact that the Patent and Trademark Office registered the green-gold color of its press pads, arguing the decision of the Ninth Circuit "failed to completely give deference to the statutory construction and factual findings of the Patent and Trademark Office" (*Petition,* p. 18). However, the Ninth Circuit did not disturb any factual findings of the Patent and Trademark Office. The opinion of the Ninth Circuit on the issue of protectibility of the Qualitex mark was on a pure issue of law. The Ninth Circuit ruled that the color of the Qualitex press pad was not protectible as a trademark *irrespective* of any factual finding that the color had acquired secondary meaning. In any event, cancellation of the Qualitex color mark was well within the power and jurisdiction of the Ninth Circuit and no important or novel issues of law are raised thereby.

The Ninth Circuit's function as a federal appeals court does not require that it blindly and slavishly follow the decisions of the Patent and Tradmark Office. The ultimate arbiters of federal rights are the federal courts. As stated by the Ninth Circuit in *Nancy Ann Storybook Dolls* (9th Cir. 1952) 197 F.2d 293, 295, a case where the Court affirmed rejection of trademark status for the names of certain of appellants doll products:

"The Appellant makes much of the fact that these trademarks were registered by the patent office. Such registration does not, of course, bind this court. *Jacuzzi Bros. v. Berekely Pump Company*, 9 Cir. 191 F.2d 632. It is our responsibility to decide whether the registered trademark is entitled to legal protection."

In *Computerland Corp. vs. Microland Computer Corp.* (N.D. Cal. 1984) 586 F.Supp. 22, 24-5, the Court affirmed the trial court's grant of summary judgment in favor of defendant Microland notwithstanding contrary views of the Patent and Trademark Office:

"Registration of trade or service marks with the United States Copyright Office [sic] affords presumptive protection in the use of the mark. Such registration, as plaintiff did in late 1976 or early 1977, does not insulate the mark from the sort of legal challenge defendant mounts here (citing *Dollcraft*, supra.). The United States Copyright Office [sic] merely performs the mechanical function of scrivener: one sends in the fee and mark; the Office verifies that that particular mark has not yet been recorded. *Registration of the mark includes no review of the legal status of the mark; determination of whether the mark is protected against an instance of alleged encroachment is left solely within the judgment of the courts.*" (emphasis added)

In *Neva, Inc. vs. Christian Duplication Inter., Inc.* (M.D.Fla. 1990) 743 F.Supp. 1533, 1549, the Court stated:

"The Court is empowered to cancel a trademark where the validity of the mark is placed in issue. *Gear, Inc. vs. L.A. Gear California, Inc.* 670 F.Supp. 508, 512 (S.D.N.Y. 1987) ... The Court may also cancel a trademark registration within five years from the initial date of registration for any reason that would have been sufficient to deny the initial registration."

Thus, by adjudicating that the color of the Qualitex press pad was not capable of protection as a trademark, the Ninth Circuit merely performed a traditional and proper judicial function as the final arbiter of whether the subject registered mark was or is capable of trademark protection. This determination by the Ninth Circuit raises no important or novel issues of law such that this Court should grant the instant writ. If the Court were to grant *certiorari* on this basis alone, this Court would be faced with similar petitions every time a circuit court cancels a registered mark. The results of this traditional and routine judicial function should not invoke the jurisdiction of this Court.

IV.

CONCLUSION

For all of the foregoing reasons, and based on the authorities cited hereinabove, it is respectfully submitted that the instant writ should be denied in its entirety.

Dated: June 16, 1994

Respectfully submitted,

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